



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,599	02/11/2002	Koichiro Daigo	02078/LH	5934

1933 7590 02/09/2007
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
220 Fifth Avenue
16TH Floor
NEW YORK, NY 10001-7708

EXAMINER

NGUYEN, LUONG TRUNG

ART UNIT	PAPER NUMBER
----------	--------------

2622

MAIL DATE	DELIVERY MODE
-----------	---------------

02/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/073,599

Applicant(s)

DAIGO ET AL.

Examiner

LUONG T. NGUYEN

Art Unit

2622

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-19.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.



DAVID OMETZ
SUPERVISORY PATENT EXAMINER

DETAILED ACTION

Response to Arguments

THE SPECIFICATION AMENDMENTS

In re page 3, Applicants stated that the amendment filed on July 13, 2006 was not correct, since Fig. 8 (not Fig. 9) shows the Internet download in formation referred to at page 18, lines 7-16. Accordingly, the specification has been amended to revert to the original (correct) reference to Fig. 8 at page 18, lines 11 and 16.

In response, it is noted that the specification, pages 6-7, 17-18, discloses that FIG. 8 shows a conceptual diagram showing information downloaded from the Internet; FIG. 9 discloses a flowchart showing processing for downloading information from Internet. The steps S12 and S16 are disclosed in FIG. 9 (not FIG. 8). Therefore, the amendment filed on July 13, 2006, which changed "FIG. 8" to "FIG. 9" at page 18, lines 11 and 16, was correct. The original specification "FIG. 8 (step S12) and FIG. 8 (step S16)" at pages 18, lines 11 and 16, were not correct.

The Applicants allege that the specification (page 17, lines 4-7) supports the feature "an address storage unit configured to store a plurality of addresses on the network set by a user in advance."

Noted that the specification (page 17, lines 4-7) only discloses "the information download from the Internet is set up preliminary by user." This means that the information from the Internet is downloaded and then is set up preliminary by user. This is different from

Art Unit: 2622

“information on the Internet is set up preliminary by user,” which corresponds to limitation “a plurality of addresses on the network set by a user in advance.” Therefore, the Examiner considers that the specification (page 17, lines 4-7) does not support the feature “a plurality of addresses on the network set by a user in advance.” as amended in page 3 of the Amendment filed on 7/13/2006.

The Examiner considers that the specification also does not support the features “reading a plurality of addresses on a network which are set by a user in advance” as amended in page 6 of the Amendment filed on 7/13/2006; “the image recording unit adds information obtained from the server unit through the network, based on a plurality of addresses set by a user in advance” as amended in page 9 of the Amendment filed on 7/13/2006; “to obtain information from the server unit based on a plurality of addresses set by a user in advance” as amended in page 11 of the Amendment filed on 7/13/2006.

THE CLAIM REJECTION.

The rejection of claims 1-19 under 35 U. S. C. 112, first paragraph is maintained for the reasons discussed below.

In re pages 4-5, Applicants argue that the specification (page 17, lines 4-7) supports the limitation “an address storage unit configured to store a plurality of addresses on the network set by a user in advance” as amended in claim 1.

In response, noted that the specification (page 17, lines 4-7) only discloses “the information download from the Internet is set up preliminary by user.” This means that the information from the Internet is downloaded and then is set up preliminary by user. This is

Art Unit: 2622

different from “information on the Internet is set up preliminary by user,” which corresponds to limitation “a plurality of addresses on the network set by a user in advance.” Therefore, the Examiner considers that the specification (page 17, lines 4-7) does not support the limitation “a plurality of addresses on the network set by a user in advance.” In order to have the specification supports the limitation “a plurality of addresses on the network set by a user in advance” as amended in claim 1, claim 1 should be amended as “an address storage unit configure to store a plurality of addresses, which is downloaded from the network, set by a user in advance,” which is supported by “the information download from the Internet is set up preliminary by user” in the specification (page 17, lines 4-7).

As for limitation “reading a plurality of addresses on a network which are set by a user in advance” in claim 7; limitation “wherein the image recording unit adds the information, which is obtained from the server unit by the image recording unit through the network based on a plurality of addresses set by a user in advance” in claim 13; limitation “to obtain the information from the server unit through the network based on a plurality of addresses set by a user in advance” in claim 16, the Examiner considers that the original disclosure does not support for these limitations for the reason discussed above respect to claim 1.

Noted that the other Applicants’ arguments filed on 7/13/2006 are persuasive.

Art Unit: 2622

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUONG T. NGUYEN whose telephone number is (571) 272-7315. The examiner can normally be reached on 7:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DAVID L. OMETZ can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LN LN
02/06/07



DAVID OMETZ
SUPERVISORY PATENT EXAMINER